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Total Number of Pages in This Submission: 8

Application Number	09/945,378
Filing Date	08-31-2001
First Named Inventor	GRAHAM, ET AL
Art Unit	3622
Examiner Name	BEKERMAN, MICHAEL
Attorney Docket Number	CGR03-GN003

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☑ Amendment/Reply
  - ☑ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
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- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/ Incomplete Application
  - ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
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- ☐ Petition
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- ☐ Terminal Disclaimer
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- ☐ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
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  ITEMIZED RETURN POST CARD

Remarks

REPLY BRIEF (6 PGS)

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	TAFT STETTINIUS & HOLLISTER LLP		
Signature			
Printed name	DAVID A. MANCINO		
Date	02-09-2009	Reg. No.	39,289

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Sharon Shelton
Sharon Shelton

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Applicant	:	Graham, et al.
Filed	:	August 31, 2001
Serial No.	:	09/945,378
Title	:	COMPUTERIZED SYSTEM AND METHOD FOR PROVIDING ADVERTISING TO A CONSUMER
Docket No.	:	CGR03-GN003
Examiner	:	Bekerman, Michael
Art Unit	:	3622

Hon. Commissioner for Patents
Alexandria, VA 22313

Dear Sir:

REPLY BRIEF

The instant appeal is from a final rejection dated September 6, 2006. This Reply Brief is timely submitted in accordance with 37 C.F.R. § 41.41 and is in response to the Examiner's Answer mailed December 9, 2008.

Applicant wishes to maintain the appeal in this matter. The previous and new grounds of rejection are addressed below.

I. Previously Stated Grounds of Rejection – 35 U.S.C § 103

A. McIntyre fails to disclose the element for which it is cited.

As discussed in the previously filed Reply Brief, contrary to the Examiner's assertions,[1] McIntyre[2] does not disclose the step of the rejected claims for which it is cited: "providing the statistical report to the commercial entity." In fact, the portion of McIntyre cited by the Examiner merely describes a "software program keeping track of the number of times contest information is provided on behalf of one of said sponsors and allocating a cost to each of said sponsors on which contest information has been provided."[3] Because none of the cited combinations of references discloses the above-mentioned claim element, each of the 35 U.S.C. § 103(a) rejections at issue in this appeal is improper.

In an attempt to remedy this deficiency, the Examiner argues that "[t]he act of billing inherently comprises providing certain key information to the entity being billed"[4] and, therefore, a bill based on a number of times an advertisement is viewed should be considered a statistical report. This argument ignores the Office's own guidance pertaining to inherency: "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."[5]

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[1] First Examiner's Answer page 3 ("McIntyre teaches a statistical report that keeps track of how many times a game is played and the sending of this report to the sponsors of the game (Paragraph 0008).").
[2] U.S. Patent Application Publication No. 2003/0191690.
[3] U.S. Patent Application Publication No. 2003/0191690 paragraph [0008].
[4] First Examiner's Answer page 3.
[5] MPEP 2112.IV (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981)).

While a bill based on the number of times an advertisement is viewed may include a statistical report, such a statistical report is not "necessarily present"[6] in such a bill. For example, a bill for advertising may merely indicate a balance due. If such a balance due is calculated using factors in addition to the number of times an advertisement was viewed, it would be unreasonable to term the bill a "statistical report" as no statistical information, other than a total amount due, could be gleaned from it. As McIntyre does not disclose, for example, a bill showing a cost breakdown or a bill based solely on the number of times an advertisement is viewed, McIntyre does not inherently disclose the step of "providing the statistical report to the commercial entity." Accordingly, this element of the claims is not disclosed in the cited combinations of prior art and each of claim rejections under 35 U.S.C. § 103(a) should be reversed.

B. The material printed on the statistical report is functionally related to the claimed method.

As also discussed in the previously filed Reply Brief, despite the Examiner's argument that claims 64-65 and 68-70 "simply set forth the type of information conveyed in the report"[7] and his conclusory statement that "the illustrated information is simply non-functional descriptive material,"[8] claims 64-65 and 68-70 include proper functional limitations.

As an example, claim 64 is dependent upon claim 33 and, therefore, includes all of the limitations of claim 33. As such, "the statistical report" in claim 64 refers to "the statistical report" of claim 33. In claim 33, "the statistical report" is generated from data associated with the consumer's interactions with the interactive advertising. Therefore, for the statistical report to illustrate the number

[6] See MEPE 2112.IV (citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) ("To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' ").
[7] First Examiner's Answer page 8.
[8] First Examiner's Answer page 8.

of first-time accesses of consumers to the interactive advertising message over a period of time (as required by claim 64), the gathering and generating steps must include data pertaining to the number of first-time accesses over that period of time. As such, varying the information to be illustrated in the statistical report affects the scope of the data gathered and the generation of the report. Thus, the method is not be performed exactly the same for reports illustrating different information and the illustrated information is not "simply non-functional descriptive material." Accordingly, the rejection of claims 64-65 and 68-70 should be reversed as the cited combination of references does not teach such data content.

II. New Grounds of Rejection - 35 U.S.C. § 101

Claims 33-49, 64-66 and 67-70 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. While the Examiner's Answer cites a test for determining statutory subject matter, it fails to provide any reasoning as to why the claimed invention does not satisfy the test.

In re Bilski, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008) recently examined the test for determining statutory subject matter. The Court stated that "A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing."

Claims 33-49, 64-66 and 67-70 are directed to statutory subject matter, as they sufficiently satisfy both parts of the "machine-or-transformation" test of *Bilski,* although only one part of the test needs to be satisfied.

Regarding independent claim 33, the computerized method for measuring a consumer's perception of a commercial entity's brand equity, logo, trademark, tradename, tag line, product name and the like, may be implemented via a computer or other computerized machine. The computer or other computerized

machines are particular machines or apparatuses, which satisfy the machine aspect of *Bilski's* test. Further, the transformation of gathered data associated with a consumer's interactions into a statistical report that is provided to the commercial entity certainly satisfies the transformation aspect of *Bilski's* test.

Claims 34-49 and 64-66 depend from claim 33, and are therefore allowable for at least the same reasons.

Regarding independent claim 67, the computerized method for at least one of providing advertising to a consumer and for gathering statistical data from the consumer associated with at least one of a commercial entity's products and services may be implemented via a computer or other computerized machine. The computer or other computerized machines are particular machines or apparatuses, which satisfy the machine aspect of *Bilski's* test. Further, the transformation of gathered data associated with a consumer's interactions into a statistical report that is provided to the commercial entity certainly satisfies the transformation aspect of *Bilski's* test.

Claims 68-70 depend from claim 67, and are therefore allowable for at least the same reasons.

Accordingly, the rejection of claims 33-49, 64-66 and 67-70 should be reversed, as the claimed invention is directed to statutory subject matter.

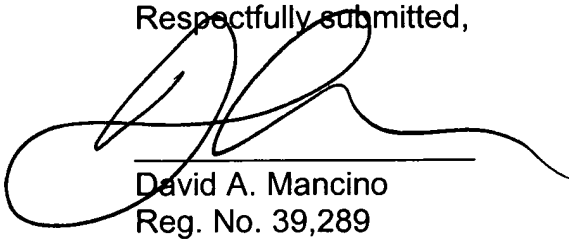
III. Conclusion

In light of the foregoing, it is respectfully submitted that claims 33-49, 64-66 and 67-70, now pending, are distinguishable from the references cited, directed to statutory subject matter and in condition for allowance. Reconsideration and withdrawal of the rejections of record is respectfully requested.

The Commissioner for Patents is hereby authorized to charge any fees that may be required by this paper, or to credit any overpayment to Deposit Account 50-3072.

In the event that the Examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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